

REMARKSClaim Status:

Claims 1-48 are pending in the application. Dependent claims 43-48 are newly presented.

Claims 14, 22 and 26 are amended without prejudice to variously recite utilizing a configured multi-purpose electronic processor.

Information Request:

The undersigned is unaware of any documents that would anticipate or raise an on-sale bar to the presently claimed invention. Nevertheless, we will file an Information Disclosure Statement that discloses patent documents in which assignee previously described watermarking ID related documents.

The Examiner is invited to contact the undersigned with a specific document request, if any.

Statutory Subject Matter:

We respectfully traverse the rejections under 35 U.S.C. § 101. Nevertheless, and without conceding the merits of these rejections, claims 14, 22 and 26 are amended to variously recite utilizing a configured multi-purpose electronic processor.

Withdrawal of this rejection is requested.

Art-based Rejection:

Claims 35, 38 and 40-42 are rejected as being anticipated by U.S. Patent No. 6,748,533 (hereafter “Wu”). Claims 1-6, 10-13, 22-25 and 39 are rejected as being unpatentable over Wu. Claims 7-9 and 36-37 are rejected as being unpatentable over Wu in view of U.S. Patent No. 6,907,528 (“Bunn”). Claims 14-21 and 26-34 are rejected as being unpatentable over U.S. Published Patent Application No. US 2002-0073010 A1 (“Tresser”) in view of Wu.

We respectfully traverse these rejections.

Claim 35 in view of Wu

It is well settled that in order for an Office Action to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. See generally, *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

The final Office Action does not establish a *prima facie* case of anticipation since the Wu patent does not have each and every element of claim 35; namely, it does not have a first digital watermark including a first payload, the first payload comprising a representation of the document identifier, and a second digital watermark including a second payload, where the *second payload includes at least a reduced-bit representation of the first payload*.

The Office Action cites Wu at Col. 6, lines 35-67, as anticipating these features. *Please see* the Office Action, page 4, paragraph 11.

We respectfully disagree.

For example, we see no discussion at the cited passage of at a second digital watermark (having a second payload), where the second payload includes at least *a reduced-bit representation* of the first payload.

Claim 35 stands ready for allowance over Bunn.

Claim 1 in view of Wu

Claim 1 recites a **license plate** for attachment to a motor vehicle, the license plate comprising auxiliary data steganographically embedded therein.

The Office Action states that watermarking was convention and well known at the time of the invention. We don't disagree with such a highly generalized statement. We do disagree, however, that it was well known to apply steganographic auxiliary data to license plates.

Wu does not have or render obvious such, nor does it provide any discussion of the problems or benefits of doing so.

The conclusion reached in the Office Action, e.g., that it would have been obvious to provide a license plate with steganographic encoding is not supported. That is, it simply makes the assertion without providing any justification.

Claim 1 stands ready for allowance over Wu.

Claim 4 in view of Wu

Claim 4 recites that a digital watermark comprises an orientation component.

The Office Action cites to Wu at Col. 6, lines 35-67 for these features. See the Office Action, page 7, under the paragraph starting “Regarding Claim 4”.

We disagree. In fact, we see no mention or inference of a watermark “orientation component” in the cited passages, reproduced below for convenience.

In another embodiment, relevant information in portions of an electronic product are linked to other respective portions of the document in a cryptographic way based on invisible or visible watermarks. That is, information in a first portion of an electronic document, for example, is embedded as an invisible watermark in a second portion of the document. Information in the second portion is embedded as a watermark in a third portion. Likewise, information in the third portion can be embedded as a watermark in the first portion. Numerous other combinations and arrangements are possible.

Preferably, the product has a unique feature representation of a biometric characteristic of its owner (e.g. a facial image) printed on a first portion of the product. Using a facial recognition method, invariant features can be extracted from the first representation to form the second representation of biometric characteristics of the owner. The second representation is coded and encrypted as input for the first watermark generator. The first watermark generated (the third representation of a biometric characteristic of the owner) is printed onto a second portion of the product.

The second portion of the product may have also a first unique feature representation of another biometric characteristic of the owner, such as a picture of the person's fingerprint printed on the second portion. Using a fingerprint recognition method, invariant features can be extracted from-the above first representation (i.e. fingerprint picture) to form the second representation of the biometric characteristic of the owner. The second representation is then coded and encrypted as input of a second watermark generator. The second watermark generated (the third representation of a biometric characteristic of the owner) is printed....

The Office Action overstates the significance of Wu; indeed, we see nothing in the above passages that would render obvious the features of claim 4 including a watermark orientation component.

We ask that the rejection of claim 4 be removed.

Claim 6 in view of Wu

Claim 6 recites that the first of the payload fields includes first plural-bit data to uniquely identify the motor vehicle.

The Office Action cites to Wu at Col. 6, lines 35-67 for these features. See the Office Action, page 7, under the paragraph starting “Regarding Claim 6”.

We disagree. In fact, we see no mention or inference of the payload fields includes first plural-bit data to uniquely identify the motor vehicle in the cited passages.

Here again, the Office Action overstates the significance of Wu; indeed, we see nothing in the cited passages that would render obvious the features of claim 6, including first plural-bit data to uniquely identify the motor vehicle.

We ask that the rejection of claim 6 be removed.

Claim 12 in view of Wu

Claim 12 recites that the auxiliary data (of claim 3) comprises an identifier to be used to interrogate a data structure, the data structure comprising information associated with the vehicle or with an owner of the vehicle.

The Office Action cites broadly across Cols. 5-6 for these features. See the Office Action, page 7, under the paragraph starting “Regarding Claim 12”.

We disagree. In fact, we see no mention or inference an identifier to be used to interrogate a data structure, the data structure comprising information associated with the vehicle or with an owner of the vehicle in the cited passages.

Here again, the Office Action overstates the significance of Wu.

We ask that the rejection of claim 12 be removed.

Claim 22 in view of Wu

Claim 22 recites – in combination with other features – a method to authenticate documentation associated with a motor vehicle. The Office Action fails to cite any Wu passages (see the Office Action, page 6), but maintains that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to extend Wu’s invention to other documentation since Examiner take Official Notice that it was conventional and well known.” See the Office Action, page 6, lines 15-18.

We disagree with this type of reasoning since it is circular. That is, the rejection is premised on alleged facts that it seeks to prove. This type of rejection cuts against the clear requirements set forth by the Federal Circuit.

For example, the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR, 82 USPQ2d at 1396 (approving the Federal Circuit statement).

The rejection of claim 22 fails to set forth a *prima facie* case of obviousness and should be removed.

Claim 7 in view of Wu and Bunn

Claim 7 recites that the first plural-bit data comprises *a reduced-bit representation of a vehicle identification number (VIN)* assigned to the motor vehicle.

We see no discussion of this combination in Office Action, pages 8-9, paragraph 14.

For example, there is no discussion of a reduced-bit representation of a vehicle identification number.

Thus, the Office Action fails to establish a prima facie case of obviousness on its face.

The rejection of claim 7 should be removed.

Claim 8 in view of Wu and Bunn

Claim 8 recites that the first plural-bit data comprises a cryptographic permutation of a vehicle identification number (VIN) assigned to the motor vehicle.

We see no discussion of this combination in Office Action, pages 8-9, paragraph 14.

For example, there is no discussion of first plural-bit data comprising a cryptographic permutation of a vehicle identification number (VIN).

Thus, the Office Action fails to establish a prima facie case of obviousness on its face.

The rejection of claim 8 should be removed.

Claim 14 in view of Tresser and Wu

Tresser and Wu are not understood to render obvious claim 14.

For example, claim 14 recites receiving a first digital signature that is associated with a **seller** of property and receiving a second digital signature that is associated with a **buyer** of the property. Wu is cited broadly across Col. 5-6 for these features. See the Office Action, page 9, lines 11-15 of paragraph 15.

We disagree with this analysis. Indeed, these passages are not understood to have these features. Clarification, and specific reference to features and line numbers per MPEP 706.02(j), is requested if this rejection is maintained.

The rejection of claim 14 should be removed.

Claim 16 in view of Tresser and Wu

Claim 16 recites that the authentication information comprises a cryptographic permutation of at least one of the first digital signature or the second digital signature.

Wu is cited broadly across Col. 5-6 for these features. See the Office Action, page 10, under “Regarding claim 16”.

We disagree with this analysis. Indeed, these passages are not understood to have these features. Clarification, and specific reference to features and line numbers per MPEP 706.02(j), is requested if this rejection is maintained.

The rejection of claim 16 should be removed.

Claim 17 in view of Tresser and Wu

Claim 17 recites that the authentication information comprises an output of a function which includes the first digital signature and the second digital signature as inputs.

Wu is cited broadly across Col. 6-7 for these features. See the Office Action, page 10, under “Regarding claim 17”.

We disagree with this analysis. Indeed, these passages are not understood to have these features. Clarification, and specific reference to features and line numbers per MPEP 706.02(j), is requested if this rejection is maintained.

The rejection of claim 17 should be removed.

Claim 20 in view of Tresser and Wu

Claim 20 recites that the authentication information comprises a reduced-bit representation of at least one of the first digital signature or the second digital signature.

Wu is cited broadly across Col. 7-8 for these features. See the Office Action, page 10, under “Regarding claim 20.

We disagree with this analysis. Indeed, these passages are not understood to have these features. Clarification, and specific reference to features and line numbers per MPEP 706.02(j), is requested if this rejection is maintained.

The rejection of claim 20 should be removed.

Claim 26 in view of Tresser and Wu

Claim 26 recites different and separate features relative to claim 14. Nevertheless, the Office Action lumps together these two claims in its analysis. See the Office Action, page 9, paragraph 15.

Claim 26 recites a method to facilitate transfer of a motor vehicle from a seller to a buyer. The method includes: receiving into a first data record information associated with the motor vehicle or the seller of the motor vehicle; providing the buyer of the motor vehicle with a digitally watermarked object, the digital watermark comprising an identifier; associating the identifier with a second data record, the second data record including information associated with the buyer of the motor vehicle; associating the first data record with the second data record; upon presentment of the digitally watermarked object, receiving optically captured scan data representing the digitally watermarked object, and analyzing the scan data with a configured multi-purpose electronic processor to obtain the identifier, said method further comprising accessing at least the second data record via the identifier.

This combination is not addressed in the Office Action. See, e.g., the Office Action, page 9, paragraph 15.

Thus, the Office Action fails to establish a *prima facie* case of obviousness and should be removed.

Remaining Claims

We respectfully request reconsideration of all of the dependent claims.

Conclusion:

We respectfully request an early Notice of Allowance. In the meantime, the Examiner is respectfully invited to telephone the undersigned at 503-469-4685 with any questions. (Other deficiencies of the art need not be belabored at this time, but we reserve our right to do so if needed.)

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Respectfully submitted,

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